

### **REMARKS**

Claims 10-15 are pending in the present application.

#### **Rejections Under 35 U.S.C. § 102**

Claims 10, 13 and 14 are rejected under 35 U.S.C. § 102(e)(1) as allegedly being anticipated by U.S. Patent Application Publication No. US 2005/0055637 A1 to Schuller ("Schuller").

Applicants submit that their claimed invention is distinct from the disclosure of Schuller, i.e., Schuller does not contain each and every element of Applicants' claimed invention as required for a proper rejection under 35 U.S.C. § 102.

Applicants' claimed invention is directed to a method of making a label. Specifically, claim 10 requires the back side of the label to include a deadened first portion, a second portion proximate to the first portion that includes an adhesive, and a third portion proximate to the first portion that includes an adhesive.

In contrast, and as acknowledged on page 4 of the Office action, Schuller "fails to teach the presence of a third portion." Accordingly, Applicants submit that Schuller does not anticipate independent claim 10, as it does not disclose, either explicitly or implicitly, forming a label having a third portion proximate to a first portion and comprising an adhesive as recited in claim 10. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 13 and 14 depend directly from claim 10 and incorporate all of the limitations therein. Consequently, Applicants submit that these dependent claims also are not anticipated by Schuller, and respectfully request that their rejection be reconsidered and withdrawn.

#### **Rejections Under 35 U.S.C. § 103**

Claims 11, 12 and 15 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Schuller in view of U.S. Patent No. 5,702,127 to Korondi ("Korondi").

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available in the art, to modify the references or to combine the teachings of the references. The Office action fails to

point out and Applicants fail to find any suggestion or motivation in either Schuller or Korondi to combine the references to provide that which Applicants claim.

More specifically, Schuller discloses label structures including at least one pre-printed information region toward the rear surface of a base paper. Schuller asserts that label structures including both a product bar code and a coupon bar code on the front surface of the label can confuse checkout scanners by the presence of two bar codes on the label. By providing the coupon bar code on the rear surface of the label and the product bar code on the front surface of the label, Schuller believes that such confusion may be prevented during scanning. (See Schuller, paragraphs [0005] and [0007].) Accordingly, Applicants submit that Schuller does not provide any teaching or suggestion to motivate a person skilled in the art to modify its teachings in a manner required to meet the limitations of Applicants' claims. Specifically, Schuller provides no motivation to add to its described label a third portion including an adhesive that is proximate to the deadened first portion. Such an additional third portion serves no purpose in Schuller's invention as well as likely increasing the cost of the label.

Korondi teaches a label form having a release liner, a label ply having a pair of substantially parallel perforations spaced apart a selected distance, and a layer of adhesive between the release liner and the label ply. The adhesive is deadened in the area between the perforations, defining a spacing strip between two labels. In use, the label ply is removed from the release ply and applied to a surface. The spacing strip then is removed so that the two labels on opposite sides of the strip are secured to the surface with a preselected distance therebetween. (See Korondi, Abstract.) The function of the spacing strip is to allow two labels to be placed in perfectly aligned orientation relative to one another, with the precise spacing between the two labels predefined. (See Korondi, col. 4, lines 54-57.)

Although Korondi discloses that the front side of the spacing strip may be printed with indicia to remind the user to remove the spacing strip after placement of the label, there is no teaching or suggestion to motivate a skilled artisan to apply ink to the *back* side of the spacing strip, especially in light of the fact that the spacing strip is intended to be removed and discarded immediately after placement of the label. That is, the portion of the label having a deadened back is removable for an entirely different purpose than the corresponding label portion in

Schuller. Accordingly, Applicants submit that like Schuller, Korondi lacks any suggestion or motivation to be modified in a manner required to meet the limitations of Applicants' claims.

In sum, neither Schuller nor Korondi teaches or suggests making a label, the back side of which includes a deadened first portion, a second portion proximate to the first portion and including an adhesive and a third portion proximate to the first portion and including an adhesive, and applying an ink to the deadened first portion, as recited in claim 10. Further, neither Schuller nor Korondi provides any suggestion or motivation to combine their teachings to provide that which Applicants claim. Therefore, Applicants submit that the combination of Schuller and Korondi is improper and respectfully request that the Examiner reconsider and withdraw the § 103 rejection based on the combination of Schuller and Korondi.

To the extent the Office action suggests that it would have been obvious to provide a third portion proximate the deadened first portion of the label in Schuller because it would have been duplication of the second portion, Applicants respectfully disagree. That is, the third portion of Applicants' claimed label is not mere duplication of an essential working part of a device that involves only routine skill in the art.

For a single prior art reference to render a claimed invention obvious, there must be a sufficient showing of a suggestion or motivation for modifying the disclosure of that reference necessary to reach the claimed invention. This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved.

As discussed above, Schuller provides no suggestion or motivation to include a third portion to the label as claimed by Applicants. Further, as for the problem to be solved, Schuller does not require a third portion as the distinct bar codes are independently printed on the front and the back of its two portion label. Thus, a skilled artisan would not be motivated by Schuller to duplicate the second portion of Applicants' claimed label as a third portion because doing so would add additional expense to the label as well as create a removable portion secured by two adhesive portions, thereby making the removable portion more difficult to detach. The only potential teaching for any such motivation is Applicants' own patent application, and using Applicants' own invention to supply the motivation for supporting an obviousness rejection is inappropriate.

In conclusion, Applicants submit that claims 10-15 are novel and unobvious over the cited references, either alone or in combination.

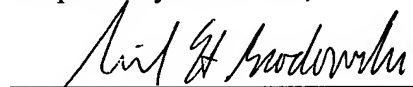
### CONCLUSION

In light of the foregoing remarks, Applicants respectfully submit that the pending claims are now in condition for allowance. The Examiner is respectfully urged to contact the undersigned attorney with any questions regarding this paper or to schedule an interview to discuss any aspect of this application.

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Respectfully submitted,



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